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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/841,741	04/25/2001	Peter Lind	00204RegUS/PHRM-0440	3271

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EXAMINER

ULM, JOHN D

ART UNIT	PAPER NUMBER
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1646

15

DATE MAILED: 04/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

72-15

# Office Action Summary

Application No.

09/841,741

Applicant(s)

Lind et al.

Examiner

John Ulm

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jan 28, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-79 is/are pending in the application.
- 4a) Of the above, claim(s) 1-29 and 36-79 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 30-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 9, 7, 8, 10, 11
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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1) Claims 1 to 79 are pending in the instant application. Claim 32 has been amended as requested by Applicant in Paper Number 13, filed 28 January of 2003.

2) Claims 1 to 29 and 36 to 79 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 13. The traversal is on the ground(s) that a search of the different inventions in a single application would pose no undue burden. This is not found persuasive because M.P.E.P. 803 states that:

“ For purposes of the initial requirement, a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in MPEP § 808.02. That prima facie showing may be rebutted by appropriate showings or evidence by the applicant.”

Serious burden was shown in the original requirement by the separate classification and separate status in the art of the different inventions. Applicant has provided neither a showing or evidence to the contrary.

The requirement is still deemed proper and is therefore made FINAL.

3) Claims 30 to 35 are objected to as being dependant from non-elected claims

4) Claims 30 to 35 stand objected to under 37 CFR 1.75(c), as being of improper dependent form for those reasons of record in section 2 of Paper Number 9.

5) The tables presented on pages 11, 26, 27, 59 and 60 of the instant specification do not comply with 37 C.F.R. 1.52 (b) with respect to line spacing. 37 C.F.R. 1.52 (b) states that:

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“ Except for drawings, the application papers (specification, including claims, abstract, oath or declaration, and papers as provided for in this part) and also papers subsequently filed, must have each page plainly written on only one side of a sheet of paper, with the claim or claims commencing on a separate sheet and the abstract commencing on a separate sheet. See §§ 1.72(b) and 1.75(h). The sheets of paper must be the same size and either 21.0 cm. by 29.7 cm. (DIN size A4) or 21.6 cm. by 27.9 cm. (8 ½ by 11 inches). Each sheet must include a top margin of at least 2.0 cm. (3/4 inch), a left side margin of at least 2.5 cm. (1 inch), a right side margin of at least 2.0 cm. (3/4 inch), and a bottom margin of at least 2.0 cm. (3/4 inch), and no holes should be made in the sheets as submitted. **The lines of the specification, and any amendments to the specification, must be 1 ½ or double spaced.** The pages of the specification including claims and abstract must be numbered consecutively, starting with 1, the numbers being centrally located above or preferably, below, the text. See § 1.84 for drawings.

37 C.F.R. 1.58 © states that:

Chemical and mathematical formulae and **tables must be presented in compliance with § 1.52(a) and (b), except that chemical and mathematical formulae or tables may be placed in a landscape orientation** if they cannot be presented satisfactorily in a portrait orientation. Typewritten characters used in such formulae and tables must be chosen from a block (nonscript) type font or lettering style having capital letters which are at least 0.21 cm. (0.08 inch) high (e.g., elite type). A space at least 0.64 cm. (1/4 inch) high should be provided between complex formulae and tables and the text. Tables should have the lines and columns of data closely spaced to conserve space, consistent with a high degree of legibility.

Correction is required.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6) Claims 30 to 35 are rejected under 35 U.S.C. § 101 because they are drawn to an invention with no apparent or disclosed specific and substantial credible utility. The instant application has provided a description of an isolated DNA encoding a protein identified therein as

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"nGPCR-2644", and the protein encoded thereby. The instant application does not disclose a specific biological role for this protein or its significance to a particular disease, disorder of physiological process which one would wish to manipulate for a desired clinical effect.

It is clear from the instant specification that the receptor protein described therein as "nGPCR-2644" is what is termed an "orphan receptor" in the art. This is a protein whose cDNA has been isolated because of its similarity to known proteins. There is little doubt that, after complete characterization, this protein and a nucleic acid encoding it may be found to have a specific and substantial credible utility. This further characterization, however, is part of the act of invention and until it has been undertaken Applicant's claimed invention is incomplete.

Whereas one could readily employ a putative receptor protein encoded by the claimed nucleic acid in an assay to identify ligands thereto the information obtained thereby would be of little use until one discovers the identity of those physiological processes moderated by that putative receptor. Because the instant specification has failed to credibly identify a physiological process which has been shown to be influenced by the activation or inhibition of a putative receptor protein of the instant invention an artisan would have no way of predicting what effects the administration of that ligand to an organism would have. If one can not predict the effects that the administration of a ligand of the putative receptor of the instant invention is going to have on an organism then it is unclear as to what practical benefit is derived by the public from the identification of that ligand.

The instant situation is directly analogous to that which was addressed in *Brenner v. Manson*, 148 U.S.P.Q. 689 (Sus. Ct, 1966), in which a novel compound which was structurally

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analogous to other compounds which were known to possess anti-cancer activity was alleged to be potentially useful as an anti-tumor agent in the absence of evidence supporting this utility. The court expressed the opinion that all chemical compounds are "useful" to the chemical arts when this term is given its broadest interpretation. However, the court held that this broad interpretation was not the intended definition of "useful" as it appears in 35 U.S.C. § 101, which requires that an invention must have either an immediately obvious or fully disclosed "real world" utility. The court held that:

“The basic quid pro quo contemplated by the Constitution and the Congress for granting a patent monopoly is the benefit derived by the public from an invention with substantial utility”, “ [u]nless and until a process is refined and developed to this point-where specific benefit exists in currently available form-there is insufficient justification for permitting an applicant to engross what may prove to be a broad field”, and “a patent is not a hunting license”, “ [i]t is not a reward for the search, but compensation for its successful conclusion.”

The instant claims are drawn to an isolated nucleic acid encoding a protein of as yet undetermined function or biological significance. There is absolutely no evidence of record or any line of reasoning that would support a conclusion the a protein of the instant invention is associated in any way with the plurality of causally unrelated disorders that are listed on pages 32, 40, and 47 to 50 of the instant specification. Until some actual and specific significance can be attributed to the protein identified in the specification as “nGPCR-2644”, or the gene encoding it, the instant invention is incomplete. The protein encoded by a DNA of the instant invention is a compound known to be structurally analogous to proteins which are known in the art as G protein-coupled

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receptors. In the absence of a knowledge of the natural ligands or biological significance of this protein, there is no immediately obvious patentable use for it. To employ a protein of the instant invention in the identification of substances which inhibit or induce its activity is clearly to use it as the object of further research which has been determined by the courts to be a utility which, alone, does not support patentability. Since the instant specification does not disclose a credible "real world" use for "nGPCR-2644" then the claimed invention is incomplete and, therefore, does not meet the requirements of 35 U.S.C. § 101 as being useful.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7) Claims 30 to 35 are rejected under 35 U.S.C. § 112, first paragraph, as failing to adequately teach how to use the instant invention for those reasons given above with regard to the rejection of these claims under 35 U.S.C. § 101.

8) Claims 30 to 35 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. These claims encompass an isolated polypeptide comprising an amino acid sequence "homologous" to the amino acid sequence presented in SEQ ID NO:2 of the instant application. Claim 34 expressly requires an "allelic variant" of SEQ ID NO:2. The instant specification, however, only contains an adequate written description of a single protein

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within the recited genus and this protein comprises the amino acid sequence presented in SEQ ID NO:2. No homologous protein or "allelic variant" is adequately described in the instant specification. Whereas the instant claims encompass a potentially large genus of isolated proteins comprising different amino acid sequences, the instant specification does not provide a detailed description of a sufficient number of species of isolated proteins with the claimed genus to establish possession of that genus. Further, the instant specification does not describe even one "allelic variant" of SEQ ID NO:2, as require by claim 34. The description of a single isolated protein does not serve as an adequate basis for the relatively large genus of proteins encompassed by the instant claims. In the decision of *The Regents of the University of California v. Eli Lilly and Company*, 43 USPQ2d 1398 (CAFC 1997), the court held that:

"To fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that "the inventor invented the claimed invention." *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (1997); *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) (" [T]he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed."). Thus, an applicant complies with the written description requirement "by describing the invention, with all its claimed limitations, not that which makes it obvious," and by using "such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention." *Lockwood*, 107 F.3d at 1572, 41 USPQ2d at 1966.

Because the instant specification does not identify that structural feature or combination of features which define the genus of claimed polypeptides "by structure, formula, chemical name, or



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physical properties" as required by the first paragraph of 35 U.S.C. § 112 it does not provide adequate written support for the breadth of the instant claims.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9) Claims 30 to 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9.1) Claims 30 to 35 are vague and indefinite in so far as they rely upon the term "an amino acid sequence homologous to a sequence of SEQ ID NO:2". The art of molecular biology recognizes two different proteins as homologous to one another if they serve analogous functions in two different organisms or appear to be of a common evolutionary origin. Because SEQ ID NO:2 appears to correspond to the amino acid sequence of a protein belonging to the G protein-coupled receptor family, one of ordinary skill could reasonably interpret this limitation as encompassing all G protein-coupled receptors, since all members in this family share certain defining structural features and analogous biological functions and are believed to be of a common evolutionary origin. However, one of ordinary skill would not believe that Applicant intends to claim any isolated member of the G protein-coupled receptor family. Therefore, an artisan of ordinary skill would be unable to distinguish between that subject matter encompassed by this limitation and that subject matter excluded by it.

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9.2) Claims 30 to 35 are vague and indefinite in so far as they employ the term "nGPCR-2644" as a limitation. Because the instant specification does not identify that property or combination of properties which is unique to and, therefore, definitive of "nGPCR-2644" an artisan can not determine if a compound which meets all of the other limitations of a claim would then be included or excluded from the claimed subject matter by the presence of this limitation.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John D. Ulm whose telephone number is (703) 308-4008. The examiner can normally be reached on Monday through Friday from 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached at (703) 308-6564.

Official papers filed by fax should be directed to (703) 308-4242 or (703) 872-9306. Official responses under 37 C.F.R. § 1.116 should be directed to (703) 872-9307.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

A handwritten signature in black ink, appearing to be 'J. Ulm', is written over the bottom right portion of the page.